

A. Claim Objections

The Examiner has objected to claims 14-20 due to the informality of the phrase “BFE” not being spelled out, and requests that the appropriate correction be made.

Claim 14 has been cancelled and claims 15-20 have been amended to incorporate this request. Therefore, the Examiner is respectfully requested to withdraw this objection.

B. Rejection of various combinations of claims 1-20 under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Isaac *et al.* (US 5,576,364), Bouchette (US 4,692,374), and Weber *et al.* (US 5,191,734).

The Examiner rejected various combinations of claims 1-20 as anticipated by or as being obvious over Isaac, Bouchette, and Weber. The Examiner states that Isaac teaches a fibrous web saturated with a latex composition that is a blend of a water dispersible polymer and an elastomeric latex emulsion; that Bouchette teaches a fibrous web saturated with a latex composition that is a blend of two latex emulsions; and that Weber teaches a fibrous web saturated with a composition that is a combination of solution polymer, synthetic polymer, and natural polymer. The Examiner concludes that because the same type of emulsions utilized by Applicants are also used in Isaac, Bouchette, and Weber, the glass transition temperature would be inherently present. In response, applicants have amended claims 1-13 to recite a required percent bacterial filtration rate (%BFE). The Examiner also believes that because the products of Isaac, Bouchette, and Weber are made of the same material as the present invention, then the Gurley Hill porosity and %BFE would be inherently present in the Isaac, Bouchette, and Weber products.

Applicants have data that refutes this inherency argument. Specifically, an affidavit is being submitted herewith pursuant to 37 CFR § 1.132, which shows the

%BFE for a product made according to US Patent No. 6,156,677 to Brown-Reed *et al.*, which is a reference cited in the Office Action in a § 102 rejection. The testing was conducted by the same laboratory and utilized the same protocol as that used for the present invention. The value for the %BFE of the Brown-Reed product is 92.45%, which is substantially outside of the values claimed in the amended claims. While the Brown-Reed product utilizes the same polymer emulsions as the present invention, the %BFE is not the same and, therefore, the fact that two medical packagings are made from the same polymer emulsion would not lead one of ordinary skill in the art to conclude that the % BFE of the packagings would be the same. Thus, the % BFE is not inherent. An applicant relying on a comparative showing to rebut a prima facie case of obviousness must compare his claimed invention with the closest prior art. In re Merchant, 575 F.2d 865, 869, 197 USPQ 785, 788 (CCPA 1978). Here, the Applicants have done just that by comparing the % BFE of the Brown-Reed product with the presently claimed invention. Unlike the Brown-Reed product, which is a medical packaging material, like the present invention, the Isaac product is a hydrodisintegratable fibrous web used for disposable diapers and feminine care products; the Bouchette product is an antimicrobial wiper; and the Weber product is a biodegradable agricultural row cover. Therefore, the Brown-Reed product represents the closest prior art cited by the Examiner. Therefore, Applicants submit that the data provided for the Brown-Reed product is sufficient to prove that the %BFE of the Isaac, Bouchette, and Weber products, like that of the Brown-Reed product itself, is not inherent, even if the prior art discloses products made with similar materials.

In light of the evidence submitted by the Applicants, the Examiner is respectfully requested to withdraw the various rejections of claims 1-20 under 35 U.S.C. § 102 (b) as anticipated by or 103(a) as obvious over U.S. Patent No. 5,576,364 to Isaac *et al*, U.S. Patent No. 4,692,374 to Bouchette, and U.S. Patent No. 5,191,734 to Weber *et al*.

B. Rejection of claims 1-4 and 7-13 under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Brown-Reed *et al*. (US 6,156,677); and rejection of claims 5, 6 and 14-17 under 35 U.S.C. § 103(a) as being unpatentable over Brown-Reed *et al*. (US 6,156,677).

Applicants have amended claims 1-13 to include the %BFE. As explained above, it has now been shown that the %BFE is not an inherent property based on starting materials. Therefore, the rejection under § 102 over Brown-Reed should be withdrawn, as well as the § 103 obvious rejection of claims 5 and 6.

With regard to claims 14-17, the Examiner states that Brown-Reed discloses a medical packaging material with a Gurley Hill porosity of from 1 to 45 sec/100cc and that such a variable would have been recognized by one skilled in the art to allow a sterilant to reach the enclosed items, making it obvious to use a material with such a Gurley Hill porosity. However, as evidenced by the data provided by the Applicants, the Gurley Hill porosity does not dictate the %BFE of the product. The extremely high %BFE is the outstanding feature of the present invention. Applicants have submitted the %BFE measurements of the Brown-Reed product as part of an affidavit pursuant to 37 CFR § 1.132, the affiant being an inventor of the present application, to demonstrate this difference. The value for the %BFE of the Brown-Reed product is 92.45%, outside of the values claimed by Applicants in claims 15-17 (Claim 14 has been cancelled, and demonstrated by the present invention). Therefore, in light of the evidence provided,

Applicants submit that the amended claims 1-17 are patentably distinct over U.S. Patent No. 6,156,677 to Brown-Reed, *et al.*, and respectfully request the Examiner to reconsider this rejection.

C. **Rejection of claims 5 and 6 under 35 U.S.C. § 103(a) as being unpatentable over Isaac *et al.* (US 5,576,364) or Bouchette (US 4,692,374).**

With regard to the obviousness rejection of claims 5 and 6 over Isaac or Bouchette, the same rationale as stated above regarding lack of inherency applies. The Examiner should withdraw the § 103 rejection of these claims.

D. **Conclusion**

In sum, in view of the amendments to the claims and the foregoing arguments, we respectfully submit that the presently amended claims 1 - 13 and 15 - 20 are patentably distinct over the references cited by the Examiner and meet all other statutory requirements. We believe that the present Application is now in complete condition for allowance and, therefore, respectfully request the Examiner to reconsider the rejections in the Office Action and allow this Application. We invite the Examiner to telephone the undersigned should any issues remain after the consideration of this response.

Respectfully requested,

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